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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Schwab et al.

Serial No.: 09/877,597 Group No.: 2153

Filed: June 8, 2001 Examiner: L. Nash

For: SYSTEM FOR TRANSFERRING DESKTOP COMPUTER CONFIGURATION

APPELLANTS' BRIEF UNDER 37 CFR §1.192

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real parties and interests in this case are Barry H. Schwab and John G. Posa, individuals, Applicants and Appellants.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 11 claims. Claims 1-11 are pending, rejected and under appeal. Claim 1 is the sole independent claim.

IV. Status of Amendments Filed Subsequent Final Rejection

No after-final amendments have been submitted.

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V. Summary of Claimed Subject Matter

Independent claim 1 is directed to a method of transferring user preferences from one computer to another, comprising the steps of providing a transportable data storage medium; recording on the transportable data storage medium, at a first computer, information relating to a user's computer configuration preferences; receiving the transportable data storage medium at a second computer; and at least temporarily configuring the second computer in accordance with the information stored on the transportable medium (See, for example, Specification, page 3, line 9 to page 5, line 6; Figure 1). Claim 2 adds that the storage medium includes information relating to the user's preferred desktop graphical interface. Claim 3 adds that the storage medium includes information relating to wired or wireless network or dial-up communications preferences. Claim 4 adds that the storage medium includes one or more user files or information relating to a user file. (Specification, page 2, lines 10-14).

Claim 5 adds the step of accessing a remote location to at least temporarily configuring the second computer in accordance with the information stored on the transportable medium. Claim 6 sets forth that the remote location includes data or an application program desired by the user at the second computer. (Specification, page 2, lines 15-18). Claim 7 includes the step of at least temporarily configuring a second computer through re-booting the second computer or through a different user log-on. Claim 8 adds a storage medium that uses a magnetic, optical, magneto-optical, or semiconductor memory. According to claim 9, the user is prompted to retain the storage medium following the reconfiguration of second machine. Claim 10 sets forth a storage medium in the form of a disk or card, and claim 11 adds that user files stored on the storage medium are updated in accordance with the use of the second computer. (Specification, page 2, lines 19 to page 3, line 2).

VI. Grounds of Objection/Rejection To Be Reviewed On Appeal

A. The rejection of claims 1-11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,029,196 to Lenz in view of U.S. Patent No. 5,241,659 to Parulski et al.

VII. Arguments

A. Rejection of Claims 1-11 under 35 U.S.C. §103(a)

Claim 1 stands rejected under 35 U.S.C. §103(a) over Lenz ('196) in view of Parulski et al.

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('659). Lenz is directed to an automatic client configuration system that provides a system administrator with the ability to configure every client in a network with one file which resides on the server. The file contains information for setting the client's lock files, preferences, configuration information, and software versions. The configuration is performed during runtime, is automatic, and can be initiated by either the client or the server. The client contacts the server at startup for configuration information, which returns the configuration file that is used by the client to configure its system. The administrator uses the server to query the clients in the network for information, such as file version numbers. If the server determines that any of the clients need file updates, it sends the files to the specific client, which replaces the existing files with the new files sent by the server.

Parulski et al., on the other hand, is directed to the limited ability of an internal memory in a CD player to store user-generated image parameter data. This deficiency is augmented by a storage medium, such as an electrically programmable read only memory module, configured to be removably interfaced with the CD player's microcontroller for storing image parameter data that has been programmed by the user. The module can be then removed from the playback device and inserted into that or another playback device for controlling its operation. The customized image parameter data may include one or more image display parameters including contrast, image magnification, color balance, saturation, border type and border location. It may also store information from which a photofinisher may produce hard copy prints of selected images or an entirely new album disc of user selections taken from multiple discs.

Not only does Lenz teach away from Applicants' claims as a primary reference, Parulski et al. is not an analogous art, and there is no justification for the Lenz/Parulski combination. Moreover, even if so combined, Appellants' invention as claimed would not result.

The Examiner states: "Lenz describes a system to automatically configure a client's preferences and settings through a server across a network." Implicit in this remark is the acknowledgement that the control of the configuration process lies at *a remote, centralized location*, rather than with the client. The Examiner's statement further implies that the Lenz system is structured utilizing a "client-server" architecture, which requires the existence of a centrally-located computer serving multiple clients over a specific network.

The Examiner also concedes that "Lenz does not teach the application of a transportable data

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medium to save user preferences and subsequently transferring those user-defined configurations to other computer systems. Nonetheless, this feature would have been an obvious modification to the aforementioned system disclosed by Lenz as evidenced by Parulski et al." Leaving aside the content of Parulski et al., any combination that suggests that the control of the configuration process be relegated to the user (client) location directly **opposes** the teachings and purpose of Lenz. Note the following:

> "The invention provides an automatic client configuration system. The invention utilizes an efficient, easily managed and operated centralized configuration file system that allows the user to configure an entire network of clients from a centralized server." (Lenz, Col. 1, lines 51-62)

The automatic client configuration system provides the system administrator with the ability to configure every client in a network with one file. The file resides on the server and contains information for setting the client's lock files, e.g. preferences, configuration information, and software versions. Control over logical groupings of clients is possible using separate configuration files for each group: ***[In this context, as elsewhere in the disclosure, the word "user" refers to the user of the system disclosed – i.e., the System Administrator.]***

> "The centralized ability to maintain and query clients in a network eases the burden on the administrator of manually updating the software and other information on each client's machine." (Col. 4, line 66 – Col. 5, line 2)

In addition, all of the examples in Lenz specify the use of a server computer acting as the source of the configuration files. The use of a server is an obvious requirement of "server-client" architecture.

An important aspect of Lenz is the need to limit the participation of clients to authorized members. Otherwise, any computer could connect to the network and download updates to commercial software that, while licensed to the authorized members, could not legally be made available to other clients in general. Thus, there is no motivation whatsoever to convert the system of Lenz to a system in which the control has be removed from the centralized management environment.

With respect to Parulski et al., while they disclose the use of removable memory, it is within a narrow context (Col. 3, ll. 12-20): "...the limited ability of an internal memory in an optical compact disc player to store user-generated image parameter data is augmented by providing a storage medium, such as an electrically programmable read only memory module, that is configured to be removably interfaced with a CD player's microcontroller for storing image parameter data that has been (remotely)

programmed by the user." In this case, the data provided in a **second** removable storage device holds "image parameter data" that is linked to a separate **first** storage device that holds the image file itself. The need for the **second** removable storage device is acknowledged by Parulski et al. (Col. 8, lines 15-21): "Because the system of Figure 1 uses a write-once optical disc, and because CD player 20 cannot record information onto the optical disc, it is not possible to store this data onto the compact disc 40 of Figure 2. Thus, some other method of storing the data is required. While a control data memory could be permanently housed within the CD player, it is preferable that the storage device, such as EEPROM module 60 in Figure 2, be removable and insertable into one or more other playback units."

In addition, Parulski et al. indicate:

> "In accordance with the present invention, such an auxiliary, transportable, memory module is used for storing user-sourced image customizing parameters, such as contrast, image magnification, color balance, saturation, border type and border location, etc., thereby enabling the user to save, in a removable memory module, parameters that have been input to the microcontroller, as by way of a conventional, hand-held remote control (IR) unit 200. Removable memory module 60 may then be extracted from interface 58 in the playback device and reinserted into that device during a subsequent playback operation or inserted, along with its associated disc, in another playback device for controlling another reproduction unit." (Col. 6, lines 45-58)

Further:

> "The user may delete any of the programmed images by pressing the clear button 232, so that any new images may be customized by advancing to the desired image, optionally altering the appearance of the displayed image, and then pressing the store button 230. This new control data is again temporarily stored in scratchpad RAM 45 and then written to removable EEPROM module 60 when the disc is ejected, as described above. (Col. 8, line 55 – Col. 9, line 4)

Figure 3 illustrates the organization of the data stored in EEPROM module 60 for the storage of parameters which control image customization as described above. For purposes of providing an illustrative example, the memory organization of Figure 3 assumes that EEPROM module 60 is a 64K Byte memory, which corresponds to a 16-bit address space. The 64K memory is divided into four separate sections, a pointer table section 120, a video display control data section 140, an optional reprint request data section 160, and an optional album disc data section 180. The lowest addresses are used to store a pointer table 120 which stores a multiplicity of pointer entries of three different types: disc identification (ID) pointer entries, such as disc #1 pointer entry 102 and disc #n pointer entry 106,

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print request pointer entries, such as print request pointer entry 110, and album disc request pointer entries, such as album disc request pointer 114.

In this case, even data that has been input by the user requires **both** removable memory media to be available to the user.

In either of the above cases, the stored data contained in the removable memory module is related to the display of the specific images that are stored in separate image files, for the purpose of displaying those images in the manner desired by the user; it is not related to the configuration of a microprocessor or computer for purposes unrelated to the display of those images which previously have been referenced.

In rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to combine the cited references to arrive at Appellants' claimed invention. There must be something *in the prior art* that suggests the proposed combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior-art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

The Examiner must also determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an Applicants' invention, the reference must either be in the field of Applicants' endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); and Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

In this case, given that Lenz teaches away from the use of a transportable data storage medium, there is no justification to import the teachings of Parulski et al. or any other reference relating to the use

of portable memory devices. Moreover, since Parulski et al. is limited to the display of the specific images that are stored in separate image files to display those images in the manner desired by the user, there is no motivation to combine these two references for the purposes of rejection. Given that the dependant claims of this application add limitations the method of claim 1, they should be deemed allowable as well.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

Respectfully submitted,

By: _____

Date: April 8, 2005

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APPENDIX A

CLAIMS ON APPEAL

1. A method of transferring user preferences from one computer to another, comprising the steps of:

providing a transportable data storage medium;

recording on the transportable data storage medium, at a first computer, information relating to a user's computer configuration preferences;

receiving the transportable data storage medium at a second computer; and

at least temporarily configuring the second computer in accordance with the information stored on the transportable medium.

2. The method of claim 1, wherein storage medium includes information relating to the user's preferred desktop graphical interface.

3. The method of claim 1, wherein storage medium includes information relating to wired or wireless network or dial-up communications preferences.

4. The method of claim 1, wherein storage medium includes one or more user files or information relating to a user file.

5. The method of claim 1, further includes the step of accessing a remote location to at least temporarily configuring the second computer in accordance with the information stored on the transportable medium.

6. The method of claim 5, wherein the remote location includes data or an application program desired by the user at the second computer.

7. The method of claim 1, wherein the step of at least temporarily configuring the

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second computer occurs through re-booting the second computer or through a different user log-on.

8. The method of claim 1, wherein storage medium uses a magnetic, optical, magneto-optical, or semiconductor memory.

9. The method of claim 1, wherein the user is prompted to retain the storage medium following the reconfiguration of second machine.

10. The method of claim 1, wherein the storage medium is in the form of a disk or card.

11. The method of claim 1, wherein user files stored on the storage medium are updated in accordance with the use of the second computer.

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APPENDIX B

EVIDENCE

None.

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APPENDIX C

RELATED PROCEEDINGS

None.

TRANSMITTAL OF APPEAL BRIEF (Small Entity)

Docket No. VID-01702/29

In Re Application Of: **Schwab et al**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/877,597	06/08/2001	L. Nash	25006	2153	1591

Invention: **SYSTEM FOR TRANSFERRING DESKTOP COMPUTER CONFIGURATION**

COMMISSIONER FOR PATENTS:

Transmitted herewith ~~in triplicate~~ is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

February 9, 2005

☒ Applicant claims small entity status. See 37 CFR 1.27

The fee for filing this Appeal Brief is: **$250.00**

☐ A check in the amount of the fee is enclosed.

☒ The Director has already been authorized to charge fees in this application to a Deposit Account.

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. **07-1180**

☐ Payment by credit card. Form PTO-2038 is attached.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Signature

Dated: **April 8, 2005**

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on

April 8, 2005
(Date)

Sheryl L. Hammer
Signature of Person Mailing Correspondence

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